REMARKS / ARGUMENTS

This application is believed to be in condition for allowance because the claims are non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasoning for allowance, the Applicant hereby respectfully requests further examination and reconsideration of the subject patent application.

1.0 Rejections under 35 U.S.C. §103(a):

In the Office Action of September, 2003, claims 1, 4-6, 9, 11, 13, 14, 20, 24-27, 29, 35-38, 40, 41 and 50 were rejected under 35 U.S.C. §103(a) as being unpatentable over Smiga et al. ("***Smiga***," US Patent 6,421,678) in view of Thorner et al. ("***Thorner***," US Patent 6,463,443). Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over ***Smiga*** in view of ***Thorner***, and in further view of Srinivasan ("***Srinivasan***," US Patent 6,717,936). Claims 7, 8 and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over ***Smiga*** in view of ***Thorner***, and in further view of Dimitrova ("***Dimitrova***," US Patent 6,363,380). Claims 10 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over ***Smiga*** in view of ***Thorner***, and in further view of Sorenson ("***Sorenson***," US Patent 6,628,729). Claims 15, 28, 30 and 42-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over ***Smiga*** in view of ***Thorner***, and in further view of Yamakita ("***Yamakita***," US Patent 6,272,490). Finally, Claims 16-19, 21-23, 31-34, and 46-49 were rejected under 35 U.S.C. §103(a) as being unpatentable over ***Smiga*** in view of ***Thorner***, and in further view of Appelman et al. ("***Appelman***," U.S. Patent 6,539,421).

In order to deem the Applicant's claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to

one of ordinary skill in the art, ***to modify the reference or to combine reference teachings***. Second, there must be a ***reasonable expectation of success***. Finally, ***the prior art reference (or references when combined) must teach or suggest all the claim limitations***.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), ***all*** of the claimed elements of an Applicant's invention must be considered, ***especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists***. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

1.1 Rejection of Claims 1, 4-6, 9, 11, 13, 14, 20:

Independent claim 1 was rejected under 35 U.S.C. §103(a) based on the rationale that ***Smiga*** discloses several elements of the Applicant's claimed system for automatically alerting a user to available information, with the remainder of the claimed elements being disclosed by ***Thorner***.

In particular, the Office Action first suggests that ***Smiga*** discloses "parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, to identify data representing any person; identifying at least one person represented by the identified data." The Office Action offers col. 5, line 63 to col. 6, line 13 of the ***Smiga*** reference in support of this contention by suggesting that "the parser of Simga parses document, and ***identifies email addresses enclosed in the document***. The email address identifies a person." (emphasis added)

However, the Applicant respectfully suggests that the Office Action has incorrectly interpreted the cited portions of the ***Simga*** reference. In particular, rather that parsing documents to "***identify data representing any person***" and "***identifying at least one person represented by the identified data,***" ***Simga*** instead parses a free text input entered by a user to locate predefined "***keywords***" and "***data information***" (see col. 5, lines 26-38). Once the ***Simga*** parser locates a "keyword" in the user entered text data, ***Simga*** then determines whether that keyword is "linked to one or more related information objects" (see col. 5, lines 35-38). With respect to email addresses, ***Simga*** explains in col. 6, lines 4-13, that if one of the ***keywords*** identified through parsing of the user entered text is ***associated*** with an email address (specified as a match to a parsed ***keyword*** in an external "object database" (see col. 21 line 46 to col. 22, line 18), then that email address is merely "passed back to the user interface 200 and displayed by the user interface 200 in a keynote and shadow region on display device 121" (see col. 6, lines 11-13).

In other words, it should be clear that ***Simga*** is describing, in part, a system for identifying one or more predefined keywords by parsing user entered text, and then passing pack to the user any data from external databases that have been previously associated with the predefined keyword located in the parsed user entered text.

In stark contrast to the system described by ***Simga***, the Applicant describes and claims a system wherein one or more persons are first ***automatically*** identified by parsing an electronic document. That information derived from parsing the document is then used to retrieve related information from at least one electronic database, as described in further detail below. Note that one major difference here between the claimed invention and that of ***Simga*** is that ***Simga*** is simply parsing a document in order to find predefined "keywords," and then to return whatever information may have been associated with those keywords in some external database. Therefore, the Applicant respectfully suggests that in direct contrast to the position advanced by the Office Action, ***Simga*** fails to identify "***email addresses enclosed in the document***" (emphasis added) with that email address supposedly identifying a person, since ***Simga*** specifically states that it is *returning the*

email address from some external database in response to a keyword match, as described above.

Consequently, it should be clear that the ***Simga*** capability to find keywords via parsing of a ***user entered text input*** is ***not*** equivalent to parsing an electronic document to identify data representing ***any person***, as described and claimed by the Applicant. In fact, ***Simga*** has no way of determining ***what*** the keyword represents beyond simply determining whether a predefined keyword matches an entry in some external database, with that externally linked information then being returned to the user. While that externally linked information may be an email address in some cases, ***Smiga*** does not specifically identify email generic addresses enclosed in documents as suggested by the Office Action.

Further, one clear advantage of the Applicants invention over the invention disclosed by ***Smiga*** is that, unlike ***Smiga***, the Applicants do ***not*** require a user to manually enter a text input which is then parsed for locating and retrieving information relating to particular predefined keywords. In fact, rather than being forced to manually enter a text input, the user is simply ***automatically*** notified of the availability of data relating to each identified person in any of a plurality of electronic documents once that information is automatically retrieved from one or more electronic databases.

Next, the Office Action suggests that ***Thorner*** describes the claimed elements of "retrieving information relating to each identified person from at least one electronic database; notifying the user that the retrieved information is available; and using at least a portion of the retrieved information relating to one or more of the identified persons to provide at least one electronic interface for initiating communication with those identified persons."

Clearly, ***Thorner*** describes the capability to search through a plurality of databases to identify personal information in response to a manual database queries initiated via a complete or partial name entry by a user of the system described by ***Thorner***. However,

when combined with the ***Simga*** reference, the proposed combination simply produces a version of the ***Simga*** reference with enhanced database search capabilities. As neither reference discloses the claimed elements of "parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, ***to identify data representing any person***; and identifying at least one person represented by the identified data," as described above, it should be clear that the proposed ***Simga*** - ***Thorner*** combination fails to teach or describe all of the elements of the Applicant's claimed invention.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited below. Therefore, the Applicant respectfully traverses the rejection of claim 1, and thus the rejection of dependent claims 4-6, 9, 11, 13, 14, and 20 under 35 U.S.C. §103(a) over ***Simga*** in view of ***Thorner***, in view of the non-obviousness of claim 1, as cited below:

> "A system for automatically alerting a user to available information comprising:
>
> ***parsing an electronic document***, said electronic documents including any of a word processor document, an Internet Web page, a spreadsheet, and any textual and graphical data rendered on a display device, ***to identify data representing any person***;
>
> ***identifying at least one person represented by the identified data***;
>
> retrieving information relating to each identified person from at least one electronic database;
>
> notifying the user that the retrieved information is available; and

using at least a portion of the retrieved information relating to one or more of the identified persons to provide at least one electronic interface for initiating communication with those identified persons." (emphasis added)

In addition, with respect to claims 13 and 14, Applicants would like to point out these claims are directed towards ***changing the appearance of the parsed document***. Specifically, the Applicant believes that the Office Action incorrectly equates the Applicants parsed document to providing a ***separate display area*** from the user data entry region on a display device (i.e., ***Smiga's*** "shadow region") for displaying information retrieved in response to a keyword identification in the manually entered user text input. The separate display area comprising the "shadow region" is ***not*** the parsed electronic document itself, and described and claimed by the applicant. Therefore, ***Smiga*** does not disclose changing the appearance of the parsed document as disclosed and claimed by the Applicant.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above, and the nonobvious of claims 13 and 14 with respect to the claimed element regarding "dynamically modifying the appearance of the electronic document." Therefore, the Applicant respectfully traverses the rejection of claims 13 and 14 under 35 U.S.C. §103(a) over ***Simga*** in view of ***Thorner***, in view of the non-obviousness of claims 13 and 14.

1.2 Rejection of Claims 24-27, 29, and 36:

As with independent claim 1, independent claim 24 was rejected under 35 U.S.C. §103(a) based on the rationale that ***Smiga*** discloses several elements of the Applicant's claimed process for automatically providing information on a computer display device, with the remainder of the claimed elements being disclosed by ***Thorner***.

In particular, as with claim 1, the Office Action again suggests that "the parser of Simga parses document, and ***identifies email addresses enclosed in the document***. The email address identifies a person." (emphasis added)

However, the described above with respect to claim 1, Applicant again respectfully suggests that the Office Action has incorrectly interpreted the cited portions of the ***Simga*** reference. In particular, as noted above, ***Simga*** is simply parsing a document in order to find predefined "keywords," and then to return whatever information may have been associated with those keywords in some external database. Therefore, the Applicant respectfully suggests that in direct contrast to the position advanced by the Office Action, ***Simga*** fails to identify "***email addresses enclosed in the document***" (emphasis added) with that email address supposedly identifying a person, since ***Simga*** specifically states that it is *returning the email address from some external database* in response to a keyword match, as described above.

Consequently, it should be clear that the ***Simga*** capability to find keywords via parsing of a ***user entered text input*** is ***not*** equivalent to parsing an electronic document to identify data representing ***any person***, as described and claimed by the Applicant. In fact, ***Simga*** has no way of determining ***what*** the keyword represents beyond simply determining whether a predefined keyword ***typed by the user*** matches an entry in some external database, with that externally linked information then being returned to the user. While that externally linked information may be an email address in some cases, ***Smiga*** does not specifically identify email generic addresses enclosed in documents as suggested by the Office Action.

Further, it must also be noted that as discussed in the Applicant's prior response, claim 24 includes the capability to ***directly scan*** information that is being ***rendered on a computer display device***. In view of detailed description provided in the Applicant's specification, it should be clear that this is ***not*** interpreted to mean that a document is first scanned and then rendered on the display device, but that the Applicant's system is ***directly scanning the information being rendered on the display device itself*** to

identify information being rendered on that display device which represents at least one person. This embodiment is particularly useful where a document is not necessarily directly available to a computer for parsing, such as in the case where a document is viewed over a network connection (such as, for example, an Internet web page).

For example, in paragraph 68 of the Applicant's specification, the Applicant discusses one method in which information being rendered on a display device may be parsed or otherwise examined to identify information representing at least one person. In particular, in the working example discussed in paragraph 68, the Applicant explains that the claimed system ***automatically interfaces with display rendering routines of a computer system***. The display screen of a computer is rendered in response to instructions, i.e., the display input, such as, for example compiled software code, such as a typical computer program, or, interpreted page descriptions such an HTML or similar script. Consequently, this working example essentially parses ***all information viewable by the user***, as well as ***hidden text or instructions***, such as, for example, hidden text embedded in the HTML code of an Internet web page, to find persons. Specifically, the working example is capable ***scanning the display input looking*** for known names, email addresses (using the canonical form of XXX@YYY.ZZZ), phone numbers, etc., or any data that may represent a person, as described above.

Smiga appears to offer no such capability, as it appears to read the user typed text input into some sort of text buffer or the like which is then rendered to the display device. In fact, ***Smiga*** describes the feature through the reference as "a user input device for receiving an input text expression." Clearly, ***Smiga*** fails completely to describe, or in any way teach or suggest any system which interfaces with display rendering routines for directly "scanning electronic data ***being rendered on the computer display device***," as described and claimed by the Applicant.

Next, the Office Action again offers ***Thorner*** reference as describing the remaining features of the Applicant's claimed invention. However, as noted above, ***Thorner*** describes the capability to search through a plurality of databases to identify personal

information in response to a manual database queries initiated via a complete or partial name entry by a user of the system described by ***Thorner***. Therefore, when combined with the ***Simga*** reference, the proposed combination simply produces a version of the ***Simga*** reference with enhanced database search capabilities. As neither reference discloses the claimed elements of "***scanning electronic data being rendered on the computer display device*** to identify information within the electronic data that represents at least one person," as described above, it should be clear that the proposed ***Simga*** - ***Thorner*** combination fails to teach or describe all of the elements of the Applicant's claimed invention.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 24, as cited below. Therefore, the Applicant respectfully traverses the rejection of claim 24, and thus the rejection of dependent claims 25-27, 29 and 36 under 35 U.S.C. §103(a) over ***Simga*** in view of ***Thorner***, in view of the non-obviousness of claim 24, as cited below:

> "A computer-implemented process for automatically providing information on a computer display device, comprising:
>
> ***scanning electronic data being rendered on the computer display device*** to identify information within the electronic data that represents at least one person;
>
> identifying each person represented by the identified information;
>
> retrieving information relating to each identified person from at least one electronic database;
>
> providing an alert for indicating that the retrieved information is available;
>
> using at least a portion of the retrieved information relating to one or more of the identified persons to provide a user interface for initiating

communication with those identified persons via at least one electronic communication access point." (emphasis added)

1.3 Rejection of Claims 37-38, 40, 41 and 50:

Independent claim 37 was rejected under 35 U.S.C. §103(a) based on "grounds corresponding to the reasons given" for the rejection of claims 1, 4-6, 9, 11, 13, 14, and 20. Consequently, the discussion provided above with respect to the rejection of those claims also applies to the rejection of independent claim 37.

In particular, in the rejection of claims 1 and 24, the Office Action suggested that "the parser of Simga parses document, and ***identifies email addresses enclosed in the document***. The email address identifies a person." (emphasis added)

However, the described above with respect to claim 1 and claim 24, Applicant again respectfully suggests that the Office Action has incorrectly interpreted the cited portions of the ***Simga*** reference. In particular, as noted above, ***Simga*** is simply parsing a document in order to find predefined "keywords," and then to return whatever information may have been associated with those keywords in some external database. Therefore, the Applicant respectfully suggests that in direct contrast to the position advanced by the Office Action, ***Simga*** fails to identify "***email addresses enclosed in the document***" (emphasis added) with that email address supposedly identifying a person, since ***Simga*** specifically states that it is *returning the email address from some external database* in response to a keyword match, as described above.

Consequently, it should be clear that the ***Simga*** capability to find keywords via parsing of a ***user entered text input*** is ***not*** equivalent to parsing an electronic document to identify data representing ***any person***, as described and claimed by the Applicant. In fact, ***Simga*** has no way of determining ***what*** the keyword represents beyond simply determining whether a predefined keyword ***typed by the user*** matches an entry in some external database, with that externally linked information then being returned to the user.

While that externally linked information may be an email address in some cases, ***Smiga*** does not specifically identify email generic addresses enclosed in documents as suggested by the Office Action.

Further, it should be noted that as with claims 13 and 14, claim 37 includes an element directed towards ***changing the appearance of the parsed document***. Specifically, claim 37 recites the following element: "***dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved***" (emphasis added). As noted above with respect to the rejection of claims 13 and 14, the Applicant believes that the Office Action incorrectly equates the Applicants electronic document, which is the actual document examined for the purpose of "***detecting any information in the electronic document that represents at least one person***" (emphasis added), with the ***Smiga*** "shadow region." As explained above, this shadow region represents a ***separate display area*** from the ***user data entry region*** on a display device which is used for displaying information retrieved in response to a keyword identification in the manually entered user text input. The separate display area comprising the "shadow region" is ***not*** the actual electronic document itself, as described and claimed by the applicant. Therefore, ***Smiga*** does ***not*** disclose changing the appearance of the electronic document as disclosed and claimed by the Applicant.

In the rejection of claims claims 1 and 24, the Office Action offers the ***Thorner*** reference as describing the remaining features of the Applicant's claimed invention. However, as noted above, ***Thorner*** describes the capability to search through a plurality of databases to identify personal information in response to a manual database queries initiated via a complete or partial name entry by a user of the system described by ***Thorner***. Therefore, when combined with the ***Simga*** reference, the proposed combination simply produces a version of the ***Simga*** reference with enhanced database search capabilities. As neither reference discloses the claimed elements of "***detecting any information in the electronic document that represents at least one person***," and "***dynamically modifying the electronic document by changing the appearance of the***

electronic document for alerting a user that data related to each identified person has been retrieved as described above, it should be clear that the proposed ***Simga - Thorner*** combination fails to teach or describe all of the elements of the Applicant's claimed invention.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 37, as cited below. Therefore, the Applicant respectfully traverses the rejection of claim 37, and thus the rejection of dependent claims 38, 40, 41 and 50 under 35 U.S.C. §103(a) over ***Simga*** in view of ***Thorner***, in view of the non-obviousness of claim 37, as cited below:

> "A computer-readable medium having computer executable instructions for dynamically modifying an electronic document rendered on a computer display device, said computer executable instructions comprising:
>
> ***detecting any information in the electronic document that represents at least one person***;
>
> identifying each person based on a comparison of the detected information to data in at least one electronic database;
>
> retrieving data related to each identified person from at least one electronic database;
>
> ***dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved.***" (emphasis added)

1.4 <u>Rejection of Claim 2:</u>

Claim 2 was rejected under 35 U.S.C. §103(a) based on the rationale that the proposed ***Smiga - Thorner*** combination reference discloses the underlying parent claim,

i.e., claim 1, and that the elements of the dependent claim, i.e., claim 2 are obvious in further view of ***Srinivasan***.

However, as discussed above with respect to the rejection under 35 U.S.C. §103(a) of independent claim 1, which is the parent claim of claim 2, the proposed ***Smiga*** - ***Thorner*** combination reference fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on the supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claim 1 has been shown to be patentable over the proposed ***Smiga*** - ***Thorner*** combination reference, dependent claim 2 must also be patentable over the proposed ***Smiga*** - ***Thorner*** - ***Srinivasan*** combination where there is no valid rejection of the parent claim.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above. Therefore, the Applicant respectfully traverses the rejection of dependent claim 2, and requests reconsideration of the rejection of claim 2 under 35 U.S.C. §103(a) over ***Smiga*** in view of ***Thorner*** in further view of ***Srinivasan*** in view of the non-obviousness of claim 1, as cited above.

1.5 <u>Rejection of Claim 7, 8 and 39:</u>

Claims 7, 8 and 39 were rejected under 35 U.S.C. §103(a) based on the rationale that the proposed ***Smiga*** - ***Thorner*** combination reference discloses the underlying parent claims, i.e., claim 1 and 37, respectively, and that the elements of the dependent claims, i.e., claim 7, 8, and 39 are obvious in further view of ***Dimitrova***.

However, as discussed above with respect to the rejection under 35 U.S.C. §103(a) of independent claim 1, which is the parent claim of claims 7 and 8, and with respect to the

rejection of independent claim 37, which is the parent claim of claim 39, the proposed ***Smiga*** - ***Thorner*** combination reference fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on the supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claims 1 and 37 have been shown to be patentable over the proposed ***Smiga*** - ***Thorner*** combination reference, dependent claims 7, 8, and 39 must also be patentable over the proposed ***Smiga*** - ***Thorner*** - ***Dimitrova*** combination where there is no valid rejection of the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1 and 37, as cited above. Therefore, the Applicant respectfully traverses the rejection of dependent claims 7, 8, and 39, and requests reconsideration of the rejection of claims 7, 8, and 39 under 35 U.S.C. §103(a) over ***Smiga*** in view of ***Thorner*** in further view of ***Dimitrova*** in view of the non-obviousness of claims 1 and 37, as cited above.

1.6 <u>Rejection of Claims 10 and 12:</u>

Claims 10 and 12 were rejected under 35 U.S.C. §103(a) based on the rationale that the proposed ***Smiga*** - ***Thorner*** combination reference discloses the underlying parent claim, i.e., claim 1 and that the elements of the dependent claims, i.e., claims 10 and 12, are obvious in further view of ***Sorenson***.

However, as discussed above with respect to the rejection under 35 U.S.C. §103(a) of independent claim 1, which is the parent claim of claims 10 and 12, the proposed ***Smiga*** - ***Thorner*** combination reference fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on the supposed obviousness of those claims is invalid where the parent claim is shown to be

patentable over the cited art. Thus, because claim 1 has been shown to be patentable over the proposed ***Smiga*** - ***Thorner*** combination reference, dependent claims 10 and 12 must also be patentable over the proposed ***Smiga*** - ***Thorner*** - ***Sorenson*** combination where there is no valid rejection of the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, as cited above. Therefore, the Applicant respectfully traverses the rejection of dependent claims 10 and 12, and requests reconsideration of the rejection of claims 10 and 12 under 35 U.S.C. §103(a) over ***Smiga*** in view of ***Thorner*** in further view of ***Sorenson*** in view of the non-obviousness of claim 1, as cited above.

1.7 Rejection of Claim 15, 28, 30 and 42-45:

Claims 15, 28, 30 and 42-45 were rejected under 35 U.S.C. §103(a) based on the rationale that the proposed ***Smiga*** - ***Thorner*** combination reference discloses the underlying parent claims, i.e., claims 1, 24 and 37, respectively, and that the elements of the dependent claims, i.e., claims 15, 28, 30 and 42-45 are obvious in further view of ***Yamakita***.

However, as discussed above with respect to the rejection under 35 U.S.C. §103(a) of independent claim 1, which is the parent claim of claim 15, with respect to the rejection of independent claim 24, which is the parent claim of claims 28 and 30, and with respect to the rejection of independent claim 37, which is the parent claim of claims 42-45, the proposed ***Smiga*** - ***Thorner*** combination reference fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on the supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claims 1, 24 and 37 have been shown to be patentable over the proposed ***Smiga*** - ***Thorner*** combination

reference, dependent claims 15, 28, 30 and 42-45 must also be patentable over the proposed ***Smiga*** - ***Thorner*** - ***Yamakita*** combination where there is no valid rejection of the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1, 24, and 37, as cited above. Therefore, the Applicant respectfully traverses the rejection of dependent claims 15, 28, 30 and 42-45, and requests reconsideration of the rejection of claims 15, 28, 30 and 42-45 under 35 U.S.C. §103(a) over ***Smiga*** in view of ***Thorner*** in further view of ***Yamakita*** in view of the non-obviousness of claims 1, 24, and 37, as cited above.

1.8 Rejection of Claim 16-19, 21-23, 31-34, and 46-49:

Claims 16-19, 21-23, 31-34, and 46-49 were rejected under 35 U.S.C. §103(a) based on the rationale that the proposed ***Smiga*** - ***Thorner*** combination reference discloses the underlying parent claims, i.e., claims 1, 24 and 37, respectively, and that the elements of the dependent claims, i.e., claims 16-19, 21-23, 31-34, and 46-49 are obvious in further view of ***Appelman***.

However, as discussed above with respect to the rejection under 35 U.S.C. §103(a) of independent claim 1, which is the parent claim of claims 16-19 and 21-23, with respect to the rejection of independent claim 24, which is the parent claim of claims 31-34, and with respect to the rejection of independent claim 37, which is the parent claim of claims 46-49, the proposed ***Smiga*** - ***Thorner*** combination reference fails to teach or describe all of the elements of the Applicant's claimed invention. Therefore, any attempt to reject dependent claims based on the supposed obviousness of those claims is invalid where the parent claim is shown to be patentable over the cited art. Thus, because claims 1, 24 and 37 have been shown to be patentable over the proposed ***Smiga*** - ***Thorner*** combination

reference, dependent claims 16-19, 21-23, 31-34, and 46-49 must also be patentable over the proposed ***Smiga*** - ***Thorner*** - ***Appelman*** combination where there is no valid rejection of the parent claims.

Consequently, no prima facie case of obviousness has been established in accordance with M.P.E.P. Section 706.02(j) and in accordance with the holdings of *In Re Fine*. This lack of a prima facie showing of obviousness means that the rejected claims are patentable under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claims 1, 24, and 37, as cited above. Therefore, the Applicant respectfully traverses the rejection of dependent claims 16-19, 21-23, 31-34, and 46-49, and requests reconsideration of the rejection of claims 16-19, 21-23, 31-34, and 46-49 under 35 U.S.C. §103(a) over ***Smiga*** in view of ***Thorner*** in further view of ***Appelman*** in view of the non-obviousness of claims 1, 24, and 37, as cited above.

CONCLUSION

In view of the above, it is respectfully submitted that claims 1-2 and 4-50 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-2 and 4-50 and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,

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